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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,369	07/02/2001	Aziz Valliani	A-70469/MAK/LM	2759
30636	7590	02/20/2007	EXAMINER	
FAY KAPLUN & MARCIN, LLP			BORLINGHAUS, JASON M	
150 BROADWAY, SUITE 702			ART UNIT	PAPER NUMBER
NEW YORK, NY 10038			3693	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/899,369	VALLIANI ET AL.
Examiner	Art Unit	
Jason M. Borlinghaus	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 16 November 2006.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-5,12-14,16,17 and 19-30 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-5,12-14,16,17 and 19-30 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5)  Notice of Informal Patent Application

6)  Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Objections***

**Claim 5** is objected to because of the following informalities: possible improper dependency. Examiner believes that Claim 5 should depend from Claim 1 and not Claim 3. Otherwise, as claimed, the consumer is only notified when the discount is less than 100 percent and not when the discount is 100 percent.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1 – 5, 12 – 14, 16 – 17 and 19 – 30** rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US Patent 6,694,300) and Jacoves (US Patent 6,741,968).

**Regarding Claims 1 - 5**, Walker discloses a method for cross marketing products between a first company (first merchant) and a second company (merchant offering supplementary product) engaged in a bilateral cross-marketing relationship (via credit card intermediary), the method performed over an interconnected plurality of point-of-sale terminals (POS terminals) and a server (central controller), and comprising the steps of (see fig. 1; col. 5, line 13 – col. 7, line 53):

- establishing a parameter of the cross-marketing relationship (upsell condition identifier) by mutual consent of the first and second companies, the parameter including a discount (predetermined discount) on a second product (supplementary product) offered by the second company (merchant offering supplementary product) the discount contingent upon a condition at least partially satisfied by a purchase of a first product offered for sale by the first company (purchase parameter may be at least one product identifier for specifying an item purchased). (see col. 5, line 13 – col. 7, line 53);
- at the first company (first merchant), identifying a straight sale that includes the purchase of the first product by a particular consumer at a first point-of-sale terminal (POS terminals), granting the discount (upsell discount) and storing an indication of the purchase of the first product (purchase data) in a database on the server (central controller). (see col. 3, line 44 – col. 7, line 53);
- at the second company (merchant offering supplementary product), receiving a request from the particular consumer for the second product, querying the

database to determine if that the particular consumer has purchased the first product from the first company (upsell condition identifier), providing the discount on the second product (upsell discount), and updating the database to reflect the providing. (see col. 5, line 13 – col. 7, line 53);

- based on the first product being a cross-marketed product (product satisfying upsell condition identifier), calculating and recording an amount of cross-marketing revenue realized from a predetermined portion of the cost of the straight sale (purchase price) to a marketing fund account in the database. (see col. 2, lines 29 – 39; col. 3, line 44 – col. 7, line 53);
- based on the providing of the discount (upsell discount), allocating at least a portion of the cross-marketing revenue (discount price) and a predetermined portion of the cost of the discount (adjustment value) in the fund to reimburse the second company for the discount (debit first merchant, 7777, account and credit second merchant, 8901, account). (see col. 2, lines 29 – 39; col. 8, line 41 – col. 11, line 22, especially col. 10, lines 41 - 46);
- the granting comprises crediting an account of the consumer with the discount. (see col. 1, lines 57 – 60); and
- notifying the consumer of the discount (offers the upsell discount). (see col. 5, lines 14 – col. 8, line 40).

While Walker does not explicitly teach a method in which there is direct communication between the two companies but rather communication via an intermediary such as a credit card company, it would have been obvious to one having

ordinary skill in the art at the time the invention was made to combine one of the merchant entities with the credit card intermediary, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893); *In re Larson, Russler & Meldahl*, 340 F.2d 965, 967, 144 USPQ 347, 349 (CCPA 1965).

While Walker does not explicitly teach a method in which the financial information is recorded into a marketing fund account, Walker does disclose the transfer of money between “financial accounts” in relation to the cross-marketing relationship that reads on the claimed marketing fund account. Additionally, Walker does not teach the use of such marketing funds for a particular use, such as is claimed by applicant as “for the benefit of the second company” (see Claim 13). However, such claim limitations are directed to intended use and the recitation of the intended use or purpose of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use or fulfilling said purpose, then it meets the claim. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

While Walker does not explicitly state the percentage value of the discounts offered, Walker’s disclosure of discounts, in general, does read on the offering of discounts equal to 100% or less.

In the alternative, Jacoves discloses discounts of less than 100% as well as a total 100% discount. (see col. 3, lines 30 – 40).

It would have been obvious to one having ordinary skill at the time the invention was made to have modified Walker by incorporating discounts of less than 100% to a total 100% discount, as disclosed by Jacoves, allowing for the issuance of discounts within the spectrum normally utilized for discounts.

**Regarding Claim 12**, while Walker does not teach a method comprising a further parameter involving a third company, Walker does disclose numerous companies with their own respective parameters interconnected via the central controller as described in regards to Claim 1.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Walker and Jacoves by incorporating a third company with its own respective parameters to the previously disclosed system involving a first company and a second company, since it has been held that mere duplication of the essential working parts of a device, without more, involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co*, 193 USPQ 8 (CA 7); *In re Harza*, 124 USPQ 378 (CCPA 1960).

**Regarding Claims 13 – 14, 16 – 17 and 19 – 30**, Claims 13 – 14, 16 – 17 and 19 – 30 recite similar limitations as claimed in previously rejected claims, would have been obvious based upon previously rejected claims, or are otherwise disclosed by the prior art applied in previously rejected claims. Such claim limitations are therefore rejected using the same art and rationale as previously utilized.

***Response to Arguments***

Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

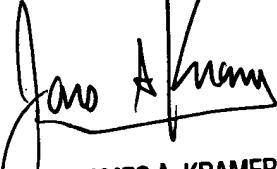
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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2/15/07  
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